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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hiroyuki HOJO et al.

Group Art Unit: 3711

Appl. No. : 10/758,019

Examiner: Kien T. Nguyen

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Confirmation No.: 5762

For : BALANCE PRACTICING MACHINE

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria VA 22314

Sir:

This request is being filed concurrently with a Notice of Appeal and is responsive to the Final Official Action of May 16, 2006 and to the Advisory Action of August 3, 2006. It is noted that the Examiner has indicated in the Advisory Action that the Amendment under 37 C.F.R. § 1.116 filed July 17, 2006 will be entered for purposes of appeal, and thus the present Request is being directed to the claims as amended therein.

Reconsideration and withdrawal of the rejection of claims 1-11, 13-18 and 21-24 under 35 U.S.C. 103(a), made in the Final Office Action, is respectfully requested in view of the following remarks.

A prima facie case of the unpatentability has not been set forth and the Rejection under 35 U.S.C. 103(a) is improper

1. Assuming, arguendo, that the teachings of YAMAGUCHI et al. and FRIEDSON have been properly combined, Applicants' claimed balance practicing machine would not have resulted from the combined teachings thereof.

Independent claims 1 and 18 set forth a balance practicing machine including, inter alia, a seat, a drive mechanism, an expandable and contractible member provided on the seating surface, and "a mechanism that repeatedly expands and contracts said expandable and contractible member during operation of the drive mechanism to provide compound motion to the seat".

The YAMAGUCHI et al. patent discloses a riding simulator. As recognized by the Examiner, the YAMAGUCHI et al. device does not include an expandable and contractible member, nor a "a mechanism that repeatedly expands and contracts said expandable and contractible member during operation of the drive mechanism to provide compound motion to the seat", as set forth in claims 1 and 18.

The FRIEDSON patent is directed to a collapsible saddle assembly. As shown in figure 7 and as described in column 4, line 55 through column 5, line 10, the FRIEDSON device includes a cavity 21 that may be filled so as to "accommodate a different user or equestrian application". The cavity may be filled with a filler material such as wool stuffing or polyurethane; or the cavity may include a bladder filled with air. In the FRIEDSON device, the cavity may be filled (with a filler material or with air) to a greater or lesser degree. Although Friedson includes an access opening 23 for inserting and removing filler (*i.e.*, expanding and contracting the cavity) or the valve 26 for filling

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and removing air from the bladder (*i.e.*, expanding or contracting the bladder), FRIEDSON does not teach or suggest that the cavity could be expanded or contracted during operation of any drive mechanism to provide compound motion to the seat. In fact, it is not at all likely that the cavity of FRIEDSON could be expanded or contracted, much less that it could be repeatedly expanded and contracted during operation of the drive mechanism since there is no teaching or suggestion whatsoever that the filler material could be removed from the cavity during movement of the device.

Accordingly, the FRIEDSON patent fails to teach or suggest a balance practicing machine or modification of the balance practicing device of YAMAGUCHI et al to include, inter alia, a seat, a drive mechanism, an expandable and contractible member provided on the seating surface, and "a mechanism that repeatedly expands and contracts said expandable and contractible member during operation of the drive mechanism to provide compound motion to the seat, as recited in claims 1 and 18.

Therefore, the FRIEDSON patent fails to cure the deficiencies of the YAMAGUCHI et al. device, and even assuming, arguendo, that the teachings of YAMAGUCHI et al. and FRIEDSON have been properly combined, Applicants' claimed balance practicing machine would not have resulted from the combined teachings thereof.

2. YAMAGUCHI et al. and FRIEDSON appear to be non-analogous art.

In this regard, YAMAGUCHI et al. is relevant to a balance practicing machine, whereas the device of FRIEDSON is relevant to a saddle for actual horse back riding. Thus, YAMAGUCHI et al. and FRIEDSON appear to be non-analogous art. Thus, the only reason to combine the teachings

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of YAMAGUCHI et al. and FRIEDSON results from a review of Applicant's disclosure and the application of impermissible hindsight. Accordingly, there is nothing in either of these references that would lead one of ordinary skill in the art to make the modification suggested by the Examiner in the rejection of claims 1 and 18 under 35 U.S.C. § 103(a) over YAMAGUCHI et al. in view of FRIEDSON.

3. The limitation "during operation of the drive mechanism to provide compound motion to the seat" cannot be considered an intended use in combination of YAMAGUCHI et al. and FRIEDSON.

Claims 1 and 18 recite, inter alia, "a mechanism that repeatedly expands and contracts said expandable and contractible member during operation of the drive mechanism to provide compound motion to the seat". Thus, the mechanism, as claimed, is required to repeatedly expand and contract the expandable and contractible member, and such repeated expansion and contraction is required to be during operation of the drive mechanism to provide compound motion to the seat. This is not intended use, but required operation of the claimed mechanism.

Accordingly, the limitation "during operation of the drive mechanism to provide compound motion to the seat" cannot be considered an intended use for at least these reasons, and any proper combination of YAMAGUCHI et al. and FRIEDSON simply does not result in Applicant's claimed "mechanism that repeatedly expands and contracts said expandable and contractible member during operation of the drive mechanism to provide compound motion to the seat" as recited in independent

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claims 1 and 18. Accordingly, the rejection of claims 1 and 18 under 35 U.S.C. § 103(a) over YAMAGUCHI et al. in view of FRIEDSON is improper for all the above reasons

CONCLUSION

Reconsideration of the Final Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Should the Examiner have any questions or comments regarding this Request, or the present application, the Examiner is respectfully invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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